

36

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in the envelope addressed to: Commissioner of Patents, Alexandria, VA 22313-1450 on

10/1/03
(Date of Deposit)
Steven J. Elleman

41,733
Reg. No.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Applicant : McCown et al.
Serial No. : 09/057,313
Filed : April 8, 1998
Title : CONTAINER TRANSPORTATION SYSTEM AND METHOD
Docket : 033449-002
Examiner : McAllister
Art Unit : 3652

Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
OCT 07 2003
GROUP 3600

Sir:

SUBMISSION OF § 1.132 DECLARATION

This paper accompanies a 37 C.F.R. §1.132 Declaration of Ralph Heim. On August 1, 2003 Applicant filed a Request for Continued Examination ("RCE"), which requested entry of the Amendment filed on June 3, 2003.

As noted in that Amendment, independent claim 16 has been amended to include the subject matter of claim 41, independent claim 22 has been amended to include the subject matter of claim 45, and independent claim 25 has been amended to include the subject matter of claim 49. As further noted in that Amendment, it is submitted that the cited references cannot be

U.S. Serial No. 09/057,313
Attorney Docket No. 033449-002
Submission of §1.132 Declaration

combined in the manner proposed in the most recent Office action to arrive at the claimed invention. In particular, the Amendment notes that the system of the proposed combination would be inoperable because the structure of the Freeman reference would not be able to accommodate the reach stacker of the Kalmar reference. The Amendment points out that the ramp of the Freeman reference would be unable to support the weight of the loaded reach stacker of the Kalmar reference, and notes that the deck of the barges of the Freeman reference cannot support the loaded reach stacker of the Kalmar reference.

Paragraph 3 of the attached Declaration provides evidence that in order to accommodate the weight of fully loaded reach stackers, vessels utilized in the system and method of the present invention must have decks that are reinforced to have weight-bearing limits beyond that of a typical deck of a vessel.

Paragraph 4 of the attached Declaration provides evidence that in order to accommodate the weight and size of fully loaded reach stackers, ramps utilized in the system and method of the present invention must be reinforced and widened to have weight-bearing limits and widths beyond those of typical ramps used for loading/unloading vessels. Thus paragraphs 3 and 4 provide further evidence to support Applicant's arguments in the Amendment.

Paragraphs 5 and 6 of the attached Declaration provide evidence of the gross revenues generated by Applicant under the TBC System (which is Assignee's commercial name for their shipping system implementing the present invention), and in particular provides evidence that the total gross revenues generated by the TBC System from about mid-1998 to about mid-2003 are over \$146 million. The number of equivalent units (i.e., a loaded module or an equivalent number of shipped motor vehicles) shipped over the same time period is over 70,500.

Paragraph 7 of the Declaration provides evidence of the relatively small advertising expenditures used to advertise the benefits of the TBC System.

As noted at paragraph 8 of the Declaration, the customers which utilize the TBC System include large, sophisticated purchasers of shipping services, including 3M, Caterpillar, Chrysler,

U.S. Serial No. 09/057,313
Attorney Docket No. 033449-002
Submission of §1.132 Declaration

Coca Cola, Dow Chemical, General Electric, General Motors, Georgia Pacific, Hewlett-Packard, Isuzu, Kraft, General Foods, Mercedes Benz, Proctor & Gamble, UPS and Wal-Mart.

Accordingly, paragraphs 5-8 of the Declaration provide clear evidence of the commercial success of the invention. This commercial success has remained strong even in light of the recent recession in the U.S. economy.

Paragraph 9 of the Declaration specifies that the TBC System provides a present marine cost, including terminal costs, of about \$400 per forty-foot equivalent (FEU) for shipping in the Puerto Rico lane, which is believed to be significantly lower (up to about 20%) than cost per FEU in the Puerto Rico lane for competitors of the TBC System. The declaration notes that the cost per FEU of the TBC System is attributable to the features of the claimed invention, including the feature of driving loading vehicles onto the vessels.

Due to the mature nature and extremely competitive nature of the shipping industry, it can be seen that the commercial success of the invention is attributable to the features of the claimed invention which provides a cost advantage. Furthermore, it can be seen that advertising revenues for the TBC System over the time period of interest are relatively modest. In particular, as noted at paragraph 7 of the attached Declaration, advertising expenditures over the period of interest are about \$70,817 which is only 0.49% of the total revenues over the same time period. Finally, paragraph 10 of the Declaration indicates that in the Declarant's professional opinion, the commercial success of the TBC system is largely due to the low cost per FEU benefits provided by the TBC system.

As noted at paragraph 11 of the Declaration, there was a long-felt need in the industry for the ability to load and unload containers without the use of cranes or "roll-on roll-off processes."

As noted at paragraph 12 of the Declaration, the present invention meets the long-felt need and provides a system for loading and unloading containers to and from marine vessels by reach stackers and does not require the use of cranes or roll-on roll-off processes.

U.S. Serial No. 09/057,313
Attorney Docket No. 033449-002
Submission of §1.132 Declaration

As noted at paragraphs 13 and 14 of the Declaration, the invention provides unexpected results because the TBC System allows containers to be loaded at otherwise inaccessible ports, and thereby extends the chain of commerce.

Accordingly, in light of the Amendment of June 3, 2003, the arguments submitted therein, as well as the Declaration accompanying this paper, it is submitted that the application is in a condition for allowance, and formal notice thereof is requested.

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or to credit any overpayment to Deposit Account 20-0809. Applicant hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



Steven J. Elleman
Reg. No. 41,733

THOMPSON HINE LLP
2000 Courthouse Plaza NE
P. O. Box 8801
Dayton, Ohio 45401-8801
(937) 443-6838

307549

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Applicant : McCown et al.
Serial No. : 09/057,313
Date Filed : April 8, 1998
Title : CONTAINER TRANSPORTATION SYSTEM AND METHOD
Docket No. : 033449-002
Examiner : McAllister
Art Unit : 3652

Assistant Commissioner for Patents
Washington, D.C. 20231

DECLARATION UNDER 37 C.F.R. §1.132

Ralph W. Heim declares and states that:

1. He is President and Chief Operating Officer of Trailer Bridge, Inc., the assignee of the above-identified patent application. He has reviewed and is familiar with the above-identified patent application.

2. He has served as President of Trailer Bridge, Inc. since November 1995 and Chief Operating Officer since January 1992. From May 1991 until November 1995, he served as Vice President of Trailer Bridge, Inc. Prior to joining Trailer Bridge in 1991, he worked at Crowley Maritime Corporation for five years in various capacities. His other transportation experience includes more than 15 years with Sea-Land, Puerto Rico Marine Management and U.S. Lines in diverse domestic and international positions. He graduated from Jacksonville University with a B.S. in Business Management.

3. In order to accommodate the weight of fully loaded reach stackers, vessels utilized in the system and method of the present invention must have decks that are reinforced to have weight-bearing limits beyond that of a typical deck of a vessel.

4. In order to accommodate the weight and size of fully loaded reach stackers, ramps utilized in the system and method of the present invention must be reinforced and widened to have weight-bearing limits and widths beyond those of typical ramps used for loading/unloading vessels.

Serial No. 09/571,803
Attorney Docket No.: 006593-1863
Declaration

5. The invention defined in the claims of this application is known and referred to at Trailer Bridge, Inc. as the "TBC System." Attachment A is a listing of gross revenue generated by operation of the TBC System and the number of equivalent units shipped under the TBC System from about mid 1998 through about mid 2003. As can be seen in Attachment A, the TBC System generated gross yearly revenues as follows:

1998 (last 30 weeks)	: \$15,143,058
1999	: \$29,800,511
2000	: \$28,803,313
2001	: \$24,739,840
2002	: \$28,378,027
<u>2003 (first 31 weeks)</u>	<u>: \$19,741,69</u>
TOTAL 1998-2003	: \$146,606,447

6. As can be seen in Attachment A, the number of equivalent units shipped under the TBC System is as follows:

1998 (first 30 weeks)	: 6,782
1999	: 13,895
2000	: 13,826
2001	: 12,384
2002	: 14,008
<u>2003 (first 31 weeks)</u>	<u>: 9,922</u>
TOTAL 1998-2003	: 70,817

An equivalent unit is a module loaded with 3 cars, or an equivalent shipping container.

7. Trailer Bridge has spent the following for advertising the benefits of the TBC System:

1998 (first 30 weeks)	: \$167,760
1999	: \$106,331
2000	: \$209,939
2001	: \$160,790
2002	: \$64,691

Serial No. 09/571,803
Attorney Docket No.: 006593-1863
Declaration

2003 (first 31 weeks) : \$12,565

TOTAL 1998-2003 : \$722,076

8. Attachment B is a list of customers that have utilized the TBC System offered by Trailer Bridge, Inc, the owner of the above-identified patent application. The list includes such customers as 3M, Caterpillar, Chrysler, Coca Cola, Dow Chemical, General Electric, General Motors, Georgia Pacific, Hewlett Packard, Isuzu, Kraft General Foods, Mercedes Benz, Procter & Gamble, UPS and Wal-Mart.

9. The TBC System provides a present marine cost, including terminal costs, of about \$400 per forty-foot equivalent unit (FEU) for shipping in the Puerto Rico lane (i.e. from Jacksonville, Florida to Puerto Rico). This figure of \$400 per FEU in the Puerto Rico lane is believed to be significantly lower (up to about 20%) than cost per FEU in the Puerto Rico lane for competitors of/alternatives to the TBC System. The cost per FEU of the TBC System is attributable to the features of the claimed invention, including the feature of driving loading vehicles onto the vessels.

10. In my professional opinion, the commercial success of the TBC system is largely due to the low cost per FEU benefits provided by the TBC system, and not due to any other factor including shipping locations and advertising.

11. Prior to the present invention, there was a long-felt need in the shipping industry for systems or methods for loading and unloading containers to and from marine vessels without requiring the use of cranes or "roll-on roll-off" processes, both of which require significant space and capital expenditure.

12. The present invention provides a system for loading and unloading containers to and from marine vessels which can be implemented by reach stackers and does not require the use of cranes or the roll-on and roll-off process. Reach stackers are in general much cheaper and more mobile than cranes, and require less space than the roll-on and roll-off process.

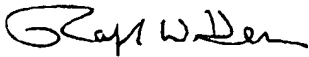
13. The present invention enables containers, including 53 foot long containers, to be loaded and unloaded to and from marine vessels using reach stackers. Thus, the system of the present invention essentially extends the chain of commerce for shipping of 53 foot long and

Serial No. 09/571,803
Attorney Docket No.: 006593-1863
Declaration

other containers to docks which do not have cranes or roll-on roll-off arrangement, or docks which are not capable of accommodating cranes or roll-on roll-off arrangements.

14. The present invention allows the loading and unloading of containers to and from marine vessels to be implemented at docks with low expenditure, little infrastructure, little space and allows loaded vessels to load from and unload to otherwise inaccessible ports.

I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Ralph W. Heim

Date: October 1, 2003

304928

ATTACHMENT A



TBC Jax barges
Revenue/billing and Equiv. Unit data Review

		<u>1998</u>	<u>1999</u>	<u>2000</u>	<u>2001</u>	<u>2002</u>	<u>2003</u>	
SB	Voyage Billing	14,128,947	27,200,290	25,978,780	22,102,154	25,942,374	17,954,268	133,306,812
	eq units	5,796	11,078	10,665	9,618	11,562	8,119	56,838
	revenue/eq unit	2,438	2,455	2,436	2,298	2,244	2,211	2,345
NB	Voyage Billing	1,014,112	2,600,221	2,824,532	2,637,687	2,435,653	1,787,430	13,299,635
	eq units	985	2,817	3,161	2,767	2,446	1,803	13,979
	revenue/eq unit	1,029	923	893	953	996	991	951
Annual Totals:								
	Voyage Billing	15,143,058	29,800,511	28,803,313	24,739,840	28,378,027	19,741,698	146,606,447
	eq units	6,782	13,895	13,826	12,384	14,008	9,922	70,817
	revenue/eq unit	2,233	2,145	2,083	1,998	2,026	1,990	2,070
Monthly Average:								
	months	4	12	12	12	12	7	59
	Voyage Billing	3,785,765	2,483,376	2,400,276	2,061,653	2,364,836	2,820,243	2,484,855
	eq units	1,695	1,158	1,152	1,032	1,167	1,417	1,200
Average/Week:								
	weeks	30	52	52	52	52	31	269
	Voyage Billing	504,769	573,087	553,910	475,766	545,731	636,829	545,005
	eq units	226	267	266	238	269	320	263

Voyage Billing - includes revenues, surcharges, and accessorial fees billed

Source Data provided by sales group. Based on individual customer bills.

Southbound Summary								
Monthly Average:								
	months	4	12	12	12	12	7	59
	Voyage Billing	3,532,237	2,266,691	2,164,898	1,841,846	2,161,865	2,564,895	2,259,437
	eq units	1,449	923	889	801	964	1,160	963
Average/Week:								
	weeks	30	52	52	52	52	31	269
	Voyage Billing	470,965	523,082	499,592	425,041	498,892	579,170	495,564
	eq units	193	213	205	185	222	262	211

Northbound Summary								
Monthly Average:								
	months	4	12	12	12	12	7	59
	Voyage Billing	253,528	216,685	235,378	219,807	202,971	255,347	225,418
	eq units	246	235	263	231	204	258	237
Average/Week:								
	weeks	30	52	52	52	52	31	269
	Voyage Billing	33,804	50,004	54,318	50,725	46,839	57,659	49,441
	eq units	33	54	61	53	47	58	52

RECEIVED
OCT 07 2003
GROUP 3600

ATTACHMENT B

TBC Customers

3M
Aaron Rents
Abbott Laboratories
ABF
Alberto Culver
Alcan
American Standard
Andrew Jergens
Ball Corp
Baxter Healthcare
Bed Bath & Beyond
Bridgestone Firestone
Caterpillar
Chrysler
Coca Cola
Continental General Tire
Copper Tire
Crane Plumbing
Crown Cork & Seal
Delta Faucet
Dow Chemical
Electrolux
Eljer Plumbing
Exide Battery
Frigidaire
General Electric
General Motors
Georgia Pacific
Gerber Plumbing
Gerber Products
Hanes/Sara Lee
Hartz Mountain
Hewlett Packard
Ingersoll-Rand
International Paper
Isuzu
JC Penney
Jim Beam
JM Smucker
Johns Manville
JVC
Keebler
Kellogg's
Kelly Springfield
Kimberly Clark
Kmart
Kraft General Foods
La Z Boy

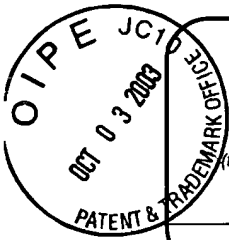
Mattel
Maytag
Mercedes Benz
Michelin
New Englang Motor Freight
New Penn Motor Express
Owens Corning Fiberglass
Pep Boys
Procter & Gamble
Quaker Oats
RJ Reynolds
Rooms To Go
SC Johnson
Sealy Mattress
Sensormatic
Simmons Bedding
The Home Depot
Thermo King
Toys R Us
Trane
United Van Lines
UPS
US Military
USF Worldwide
Visteon
Walgreens
Wal-Mart/Sams
Whirlpool
Yellow Freight

3652

PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/057,313	
	Filing Date	April 8, 1998	
	First Named Inventor	McCown et al.	
	Art Unit	3652	
	Examiner Name	McAllister	
Total Number of Pages in This Submission	9	Attorney Docket Number	033449-002

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below): Return Postcard Submission 1.132 Declaration Declaration of Ralph W. Heim Attachments A & B
Remarks The Commissioner is hereby authorized to charge any additional fees required (including the fee for any extension of time), or to credit any overpayment, to Deposit Acct. No.: 20-0809.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Thompson Hine LLP 2000 Courthouse Plaza N.E., 10 West Second Street Dayton, Ohio 45402-1758
Signature	<i>[Signature]</i>
Date	10/1/03

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Steven J. Elleman, Reg. No. 41,733
Signature	<i>[Signature]</i>
Date	10/1/03

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
OCT 07 2003
GROUP 3600